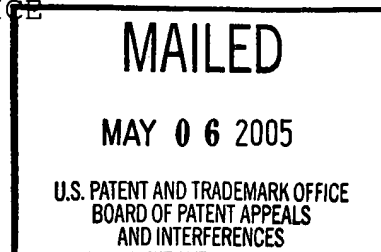The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

<u>Ex parte</u> JAMES E. ROSS, JR. and WILLIAM J. LYNCH

_____

Appeal No. 2005-0506
Application No. 09/100,100

_____

ON BRIEF

_____

Before HAIRSTON, JERRY SMITH, and GROSS, <u>Administrative Patent Judges</u>.

JERRY SMITH, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 25-29 and 37-65, which constitute all the claims pending in the application.

The disclosed invention pertains to a computer-aided method and apparatus for generation of patient medical

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documentation and reports. The generated reports are assembled

from a combination of sources including user supplied text,

system supplied pre-phrased text retrieved from a database in

accordance with a specified pre-phrased text identifier, and text

generated from input medical data facts.

Representative claim 25 is reproduced as follows:

> 25. A method for rendering a report including medical
> language from previously stored data, said method
> comprising:
>
> storing sentences and phrases related to medical data,
>
> inputting patient data at a peripheral data input device,
>
> transferring the patient data from the peripheral data input
> device to a server communicatively coupled to the peripheral
> data input device and tabling the patient data at the
> server,
>
> transferring the tabled patient data from the server to a
> report rendering component, and
>
> compiling sentences and paragraphs by the report rendering
> component from the stored sentences and phrases and the
> patient data, whereby stored medical facts associated with
> the input patient data are converted into sentence
> structure.

The examiner relies on the following references:

Amado   5,701,400   Dec. 23, 1997

Tallman et al. (Tallman) 5,764,923   June 09, 1998

Collen, Morris F., <u>Hospital Computer System</u>, 1974 by John
Wiley & Sons, Inc., pages 94-104 and 198-202.

Claims 25-29 and 37-65 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Amado in view of Collen with respect to all claims with Tallman added with respect to claims 47 and 58.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will stand or fall together in the following three groups: Group I has claims 25-27, 37-39, 42-45, 51, 55, 56 and 62; Group II has claims 28, 29, 40, 41, 46, 48-50, 52-54, 57, 59-61 and 63-65; and Group III has claims 47 and 58. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against claims 25, 28 and 47 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to representative claim 1, the examiner essentially finds that Amado teaches the claimed invention except that Amado does not explicitly disclose creating structured medical reports and stored sentences and phrases. The examiner cites Collen as disclosing such steps. The examiner finds that it would have been obvious to the artisan to include these steps in Amado [answer, pages 3-4].

Appellants argue that Amado does not disclose a method for rendering a report including medical language from previously stored data. Appellants assert that Amado has nothing to do with medical data report generation. Appellants also argue that there is no suggestion to combine the teachings of Amado and Collen to arrive at the claimed invention. Appellants argue that the combination of Amado and Collen would result in the underlying medical facts being lost which is the antithesis of the claimed invention [brief, pages 6-8].

The examiner responds that one of the areas to which the artificial intelligence teachings of Amado can be applied is medical diagnosis. The examiner also notes that Amado refers to reports and displays in several locations. The examiner finds, therefore, that Amado discloses reports, graphics, and displays which refer to the medical field. The examiner notes that Collen teaches the storing of sentences and phrases related to medical data in several locations. The examiner notes that Collen also teaches that the stored information can be coded or in natural language. With respect to the argument that there is no motivation to combine the teachings of the references, the examiner disagrees because both references are in the medical field [answer, pages 8-42].

Appellants respond that neither Amado nor Collen teaches generating reports including medical language sentences and paragraphs as recited in the claimed invention. Appellants also assert that the examiner has never pointed out where the specific claim limitations are found in the prior art. Appellants also respond that the answer fails to explain how the modification proposed by the examiner achieves the advantage asserted by the examiner. Appellants argue that the examiner's findings and

conclusions are totally unsupported by the applied prior art

[reply brief].

We will not sustain the examiner's rejection of

representative claim 25 or of any of the other claims within

Group I for essentially the reasons argued by appellants in the

briefs. In our view, the examiner's prior art evidence

establishes nothing more than that it was known to make medical

diagnostics based on artificial intelligence and to generate

medical diagnostic reports and that it was known that such

reports consist of data and language. We agree with appellants,

however, that these disparate teachings of Amado and Collen do

not result in the claimed invention even when combined, and that

there is no logical reason to combine these teachings except in

an improper attempt to reconstruct the claimed invention in

hindsight. Claim 25 recites a method for rendering a report

which is compiled from previously stored sentences, phrases and

patient data. Even if one were to generate medical diagnostic

reports as taught by Amado, there is no suggestion from Collen

that these reports should be rendered in sentence structure form

using previously stored sentences and phrases and stored patient

data. We simply cannot accept that an artisan having these two

references before him would have been motivated to arrive at the

claimed invention without using the claimed invention as a

template.

Since each of the independent claims on appeal was

included within Group I, we have not sustained the examiner's

rejection with respect to any of the independent claims. Since

we have not sustained the rejection with respect to any of the

independent claims, we also do not sustain the examiner's

rejection with respect to any of the claims which depend

therefrom. With respect to claims 47 and 58, which are rejected

using the additional teachings of Tallman, we will not sustain

the examiner's rejection of these claims because Tallman does not

overcome the deficiencies in the combination of Amado and Collen

discussed above.

In summary, we have not sustained the examiner's rejection of any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 25-29 and 37-65 is reversed.

<u>REVERSED</u>

KENNETH W. HAIRSTON
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

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APPEALS AND

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